

REMARKS

After entry of this amendment, claims 1-48 are pending. Claims 44-47 are amended to correct the dependency. No new matter is added by this amendment.

I. Rejection of claims 44-47 under 35 U.S.C. § 112.

The Office Action rejects claims 44-47 under 35 U.S.C. § 112 as providing insufficient antecedent basis for “isopropanol.” Applicants have amended these claims to correct the dependency, thereby obviating this rejection.

II. Rejection of claims 1, 4, and 31 under 35 U.S.C. §102(b) over Mahieu.

The Office Action rejects claims 1, 4, and 31 under 35 U.S.C. §102(b) over Mahieu et al., U.S. Patent No. 4,289,752 (“the Mahieu patent”). The Mahieu patent discloses cosmetic compositions containing copolymers with a base of N-alkyl acrylamide or methacrylamide. The copolymers may be packaged with an organic solvent such as methanol, isopropanol, ethanol, ethyl acetate, ethyl methyl ketone or benzene. Col. 4, lines 59-66. The Mahieu patent does not disclose hair spray compositions; however, it does teach aerosol compositions containing a copolymer, an alcohol, and a propellant. Col. 5, lines 25-33. The Mahieu patent does not teach methyl acetate or butyl acetate in such aerosol compositions, but it does disclose a nail polish with butyl acetate in example L.

Claims 1, 4, and 31 of the present invention recite “a hair care composition” in the preamble. The preamble is limiting if it breathes life into the claims. See MPEP §2111.02; Kropa v. Robie, 88 USPQ 478, 481 (CCPA 1951). In Kropa, the court concluded that the preamble phrase “an abrasive article” in a claim reciting abrasive grains and a binder was limiting because “[e]very union of substances capable *inter alia* of use as abrasive grains and a binder is not an ‘abrasive article.’” Kropa, 88 USPQ at 481.

In the present application, “a hair care composition” comprises a fixative, ethanol, and methyl acetate and/or t-butyl acetate. Like the preamble phrase in Kropa, the preamble phrase “hair care composition” is essential to point out the invention defined by

the claims, because every substance with the combination of a fixative, ethanol, and methyl acetate and/or t-butyl acetate is not a hair care composition. Thus, Mahieu does not anticipate claims 1, 4 and 31 because it does not disclose a hair care composition that includes a fixative, ethanol, and methyl acetate and/or t-butyl acetate.

The Office Action states that “[f]uture intended use does not confer patentability.” However, “intended use may further limit the claim if it does more than merely state purpose or intended use.” See MPEP §2111.02. If the prior art structure is capable of performing the intended use, then it meets the claim. The Mahieu composition disclosed in example L is for a nail polish. Hence, even if the preamble phrase does not limit claim 1, which Applicants propose *arguendo*, the Mahieu patent does not anticipate claims 1, 4 and 31 because the prior art nail polish composition is not capable of being applied as a hair care composition. As a result, Applicants respectfully request that the rejection under 35 U.S.C. §102(b) be withdrawn.

III. Rejection of claims 1-48 under 35 U.S.C. §103(a) over Mahieu, or Mahieu in view of Holloran, or Mahieu in view of Adams, or Mahieu in view of Tong.

The Office Action rejects claims 1-4, 8, and 14-48 under 35 U.S.C. §103(a) over Mahieu; claims 1-5, 8-11, and 14-48 under 35 U.S.C. §103(a) over Mahieu in view of Holloran et al., U.S. Patent Nos. 5,173,290 and 5,085,859 (“the Holloran patents”); claims 1-4, 6-12, and 14-48 under 35 U.S.C. §103(a) over Mahieu in view of Adams et al., U.S. Patent No. 5,660,816 (“the Adams patent”); and claims 1-4, 8, and 13-48 under 35 U.S.C. §103(a) over Mahieu in view of Tong, U.S. Patent No. 5,686,062 (“the Tong patent”).

The Holloran patents, which contain substantially the same specification, disclose a hair treating method for imparting curl retention by applying a film forming agent to the hair. The hair treatment compositions contain an interpenetrating polymer network that includes an organosilicon compound. Col. 4, lines 9-14. These compositions also contain a solvent, which may be water, a hydrocarbon, an alcohol, or a blend of alcohol and water. Col. 4, lines 38-48. The Holloran patents do not disclose using methyl acetate and/or t-butyl acetate as the solvent.

The Adams patent discloses a hair spray formulation composed of a sulfopolyester and a liquid vehicle “selected from the group consisting of water and a water/alcohol mixture.” Col. 2, lines 18-39. The Adams patent does not disclose using methyl acetate and/or t-butyl acetate in the hair spray formulations.

The Tong patent discloses hair fixative compositions that utilize low VOC's. To this end, the compositions are composed of greater than 50% (wt.) water and less than 50% (wt.) organic solvent. Col. 3, lines 25-30. This reference teaches that suitable organic solvents include ethanol, isopropanol, acetone, ethylene glycol dimethyl ether and methyl ethyl ketone. Col. 5, lines 4-7. The Tong patent does not teach using methyl acetate and/or t-butyl acetate in the hair fixative compositions.

All claims of the present invention recite methyl acetate and/or t-butyl acetate. Claims 1-33 and 48 are directed to hair care compositions. Claims 34-47 are directed to consumer articles that comprise a hand-held spray container and a sprayable composition.

The Office Action first argues that one skilled in the art would modify the Mahieu patent to create the claimed invention. However, there is no motivation to modify the nail polish composition of the Mahieu patent to include hair care compositions or sprayable compositions of the present invention. The Mahieu patent teaches away from using the same solvents for its nail polish, aerosol lacquers and setting lotions, as it describes different solvents for each composition. For instance, example L uses butyl acetate in the nail polish composition; while the aerosol lacquer is described as preferably an alcohol, and that of the setting lotion as a water-alcohol solution. Col. 5, lines 26-40. In contrast, the reference teaches that the same copolymer may be used in any of these three compositions.

Moreover, one skilled in the art would not be motivated to modify the solvent by adding methyl acetate and/or t-butyl acetate to the solvent system because of the unacceptable odor associated with alkyl acetates. Unlike nail polish, which is substantially odor-free when it dries, hair care compositions and other sprayable compositions preferably retain a pleasant odor upon drying. Accordingly, manufacturers typically add perfume to commercial products to allow these composition to retain a pleasant odor. In fact, all examples of hair care products in the Mahieu patent, with the

exception of example E, contain perfume. Consequently, a skilled worker would not be motivated to add a solvent with a known unacceptable odor to the aerosol lacquers and setting lotions of the Mahieu patent.

The Office Action next combines the Mahieu patent with the Hollaran patents, the Adams patent, and the Tong patent for the particular polymers and propellants taught in these secondary references. The Examiner is merely picking the butyl acetate component from Example L of the Mahieu patent and inserting that component into the compositions taught in the secondary references. None of the secondary references disclose or suggest compositions containing methyl acetate and/or t-butyl acetate.

As with the modification of the Mahieu patent, there is no motivation to combine the references. A skilled worker would not be motivated to add a solvent with a known unacceptable odor to the composition. A skilled worker would also not expect that such a combination would create a suitable hair care or sprayable composition. The Adams and Tong patents teach using water to lower VOC emissions. However, alkyl acetates form acids in the presence of water. This uncontrolled acid formation is potentially damaging to the composition and the composition user. The Tong patent teaches that acid may be added to the composition "over a period of time which is effective to provide the homogeneous solution. . . . If either the concentration of the acid is too high or the acid. . . is added too quickly, precipitation of the polymer will occur. . . and may not be rectified, regardless of further mixing." Col. 6, lines 23-35. Consequently, Applicants submit that the suggested modifications and combinations of references do not create a *prima facie* case of obviousness, and therefore, the 35 U.S.C. § 103 rejections should be withdrawn.

CONCLUSION

For the foregoing reasons, Applicants respectfully advance that the claimed invention is allowable. If the Examiner has any questions or comments, the Examiner is requested to call the undersigned.

No fee is believed due; however, the Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to Deposit Account No. 14-0629.



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Respectfully submitted,
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on the date shown below.

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June 29, 2000
Date